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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,141	09/18/2003	Kenneth A. Gan	90839.000002	8211
23387	7590	07/27/2007	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			TRAN, TUYETLIEN T	
		ART UNIT	PAPER NUMBER	
		2179		
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		07/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/666,141	GAN, KENNETH A.
	Examiner TuyetLien (Lien) T. Tran	Art Unit 2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

1. This action is responsive to the following communication: Amendment filed 06/29/07.

**This action is made final.**

2. Claims 1-3 are pending in the case. Claim 1 is independent claim. Claims 4-15 are canceled claims.

***Claim Objections***

3. Applicant's amendment corrects the previous rejection and therefore the rejection is withdrawn.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (Patent No 5740245, hereinafter Bennett) in view of Kawanaka (Patent No 6138145, hereinafter Kawanaka) further in view of Hamilton (Patent No 5176520, hereinafter Hamilton).**

***As to claim 1***, Bennett teaches:

A communication system for providing face-to-face interactive real time text messaging (e.g., see Fig. 1), the system comprising:

(a) a first and a second terminal (e.g., an associate examining attorney's terminal 17 and an attorney's terminals 15, see Fig. 1),

- each terminal having a keyboard for entering text and a display for displaying entered and received text (e.g., see Fig. 8 Fig. 6b),
- each terminal configured to transmit and receive text from the other terminal (e.g., terminal 15 and 17 provide a vehicle for the examining and associate examining attorneys to exchange messages, see col. 8 lines 58-64 and Fig. 6b),
- the first terminal configured to delete text received and displayed by the second terminal (e.g., the associate's terminal 17 provides the capability of *modifying* the communication currently present on the attorney terminal 15, see col. 23 lines 1-6),

(b) a communication link between the first terminal and the second terminal (e.g., communication link 23 as shown in Fig. 1), the communication link configured to enable communication between the first and the second terminal in a face to face position and preclude communication beyond a face to face position (e.g., see Fig. 1 items 15, 17 and 23).

However, Bennett does not expressly teach that the first terminal can invoke a display on the second terminal without displaying the display on the first terminal.

Kawanaka, teaches the first terminal (e.g., supporting-side computer 1, see col. 4 lines 1-11 and Fig. 2) configured to invoke a predetermined display (e.g., see items 32-39 in Fig. 10) on the second terminal (e.g., supported-side computer 2, see col. 4 lines 1-11 and Fig. 3) without displaying the predetermined display on the first terminal (e.g., see Fig. 9 and Fig. 10).

Bennett and Kawanaka are analogous art because they are from the same field of endeavor of providing communication between two computers. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have

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implemented the feature the first terminal can invoke a display on the second terminal without displaying the display on the first terminal as taught by Kawanaka to the real-time communication system as taught by Bennett to make it possible to carry out a real-time electronic dialog relative to a computer operated even by an operator unfamiliar with keyboard manipulation and to allow the electronic dialog between the computers to be performed easily and widely (e.g., see Kawanaka col. 7 lines 1-14).

However, Bennett and Kawanaka still do not expressly teach that:

- the second terminal configured to delete text received and displayed by the first terminal,
  - the second terminal configured to invoke a predetermined display on the first terminal without displaying the predetermined display on the second terminal;
- and

Hamilton, though, teaches a computer assisted instructional delivery system having an electronic sheet that is shared between a student and a teacher and allows both the teacher and the student to write or draw on that electronic sheet of paper simultaneously from remote locations with the image produced by one appearing on screen of the other or both. Hamilton also teaches the system further enables both teacher and student while in eraser mode allow a small rectangle of blank space to "white out" anything that is at the position. Hamilton further teaches a function that allows the teacher to control a certain message or question to display on specific display without displaying the message to other participant displays (see col. 3 lines 31-38 and col. 13 lines 42-66).

Bennett, Kawanaka, and Hamilton are analogous art because they are from the same field of endeavor of two-way communication system that transmit and receiver information from a computer or terminal to another. Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to have implemented the deleting function in second terminal as well as the function to invoke a predetermined display on the first terminal without displaying the predetermined display on the second terminal. The motivation is to provide the ability of simultaneously written interactions between users (e.g., see Hamilton col. 1 lines 55-58).

**As to claim 2,** Bennett further teaches wherein the first and the second terminals are configured to precede each displayed line of text with an identifier of the sending terminal (e.g., see Fig. 6b).

**As to claim 3,** Bennett teaches wherein the communication link includes a cable having a length to place the first and second terminals in the face-to-face position (e.g., see Fig. 1 items 15, 17 and 23).

#### ***Response to Arguments***

6. Applicant's arguments filed 6/29/07 have been fully considered but they are not persuasive.

Applicant's arguments, with respect to claim 1, that the prior art of Bennett does not teach the limitation of "the second terminal delete text received and displayed by the first terminal" (e.g., see Applicant's Remark page 4, Paragraph 5).

The Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the prior art of Bennett teaches that a communication system for providing face-to-face interactive real time text messaging system wherein the first

terminal is configured to delete text received and displayed by the second terminal (e.g., the associate's terminal 17 provides the capability of *modifying* the communication currently present on the attorney terminal 15, see col. 23 lines 1-6; note that one skill in the art would interpret the term "modifying the communication" as being deleting the communication because the term modifying, in a broad interpretation, can be interpreted as being editing or making changes). The examiner admits that Bennett does not teach the second terminal configured to delete text received and displayed by the first terminal.

However, Hamilton teaches a computer assisted instructional delivery system having an electronic sheet that is shared between a student and a teacher and allows both the teacher and the student to write or draw on that electronic sheet of paper simultaneously from remote locations with the image produced by one appearing on screen of the other or both. Hamilton also teaches the system further enables both teacher and student while in eraser mode allow a small rectangle of blank space to "white out" anything that is at the position. Hamilton further teaches a function that allows the teacher to control a certain message or question to display on specific display without displaying the message to other participant displays (see col. 3 lines 31-38 and col. 13 lines 42-66).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented the deleting function in second terminal as well. The motivation is to provide the ability of simultaneously written interactions between users (e.g., see Hamilton col. 1 lines 55-58).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275,277 (CCPA 1968)).*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuyetLien (Lien) T. Tran whose telephone number is 571-270-1033. The examiner can normally be reached on Mon-Friday: 7:30 - 5:00 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

T.T  
7/20/2007

Lien Tran  
Examiner  
Art Unit 2179



**WEILUN LO**  
SUPERVISORY PATENT EXAMINER